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John H. Jebens

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EXAMINER

COLBERT, ELLA

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/731,359

Applicant(s)

JEBENS ET AL.

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 104-112 and 121-126 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 104-112 and 121-126 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/11/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 104-112 and 121-126 are pending. Claims 104, 121, and 125 have been amended in this communication filed 10/11/05 have been entered as Amendment with filing RCE, Extension of Time, and IDS.
2. The IDS filed 10/11/05 has been reviewed and considered.
3. The 35 USC 112 second paragraph rejection for claims 104, 121, and 125 has been overcome by Applicants' convincing arguments and is hereby withdrawn.

Continued Examination Under 37 CFR 1.114

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/11/05 has been entered.

Claim Objections

5. Claims 104, 108, 121, 122, and 125 are objected to because of the following informalities: Claim 104 is objected to for the usage of "such that". Claims 108, 121, 122, and 125 have a similar problem. Claim 122 is also objected to on page 6, lines 11 and 12 which recite "provider and the authorized user, Resolution copies of the subset to the one of the first image provider and the authorized user." These lines would be better recited as "providers and the authorized user, Resolution copies of

the subset to the one of the first image providers and the authorized user.”

Appropriate correction is required.

Specification

6. A substitute specification and the claims is required pursuant to 37 CFR 1.125(a) because there are too many amendments to the Specification which will present a problem when the application is allowed.

A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

Drawings

7. The drawings are objected to because the figure numbers should either be at the bottom of the figure drawing or at the top of the drawing figure in order to be in agreement. For example, figure 1 is labeled at the top of the drawing figure, fig. 2 is labeled at the right side of the drawing figure, fig. 3 A is at the bottom of the left of the

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drawing figure, etc. The lines of figure 2 are too dark, fig. 10C needs the shading removed in elements (768, 770, 772, 774, 776, 786, and 788). The acronym "OPI" in figure 4C should be written as "open-pre-press interface (OPI)". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Regarding claims 104, 108, 121, 122, and 125, the phrase "such that" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 104 recites the limitation "high resolution digital image" in line 23 on page 2. Claims 108 has a similar problem. There is insufficient antecedent basis for this limitation in the claim.

Claims 108, 111, 112, and 124 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: in claim 108, page 3, lines 11 and 12 "... subset of the digital images to the first image provider". Claim 112 has a similar problem on page 4, line 7 and page 5, line 3; claim 124, page 7, lines 7 and 10 and page 8, line 5. Claim 111, page 4, lines 8 and 9 "the high resolution and low resolution copy of the digital image provided by the first image provider, the second digital image being transparent to the first image provider.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 104-112 and 121-126 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,666,215) Fredlund et al, hereafter Fredlund in view of (US 5,153,936) Morris et al, hereafter Morris.

With respect to claims 104 and 121, Fredlund teaches, an electronic storage facility (col. 2, lines 28-31 and col. 3, lines 32-36) for providing storage for high resolution digital images (col. 3, lines 63-67) of a plurality of unrelated image providers, at least some of the high resolution digital images stored in the electronic storage facility (col. 4, lines 10-66) being used to develop corresponding low resolution copies, each of the high resolution digital images having a higher bandwidth communication requirement than each of the corresponding low resolution copies, the electronic storage facility storing the high resolution digital images of a first one of the image providers such that the high resolution digital images of the first image provider and such that the high resolution digital images of the first image provider are can only be accessed by authorized users identified by the first image and such that the high resolution digital images of the first image provider are transparent to other unrelated image providers that are not authorized users identified by the first image provider (col. 6, lines 10-33 and fig. 2(34 & 38); means for allowing the authorized user to download the low resolution copy corresponding to one of the high resolution digital images of the first image provider from the electronic storage facility to a first location (col. 6, lines 50-63, col. 8, lines 16-27, and fig. 6 (112 & 118); and means for electronically routing the high resolution digital image to a printer in response to a request from the authorized user (col. 8, lines 45-61).

Fredlund did not teach, means for notifying an authorized user identified by the first image provider that the authorized user has been authorized to download a low resolution copy corresponding to one of the high resolution digital images, wherein the

notifying means transmits at least a portion of a pathname associated with the low resolution copy of the authorized user.

Morris disclosed, means for notifying an authorized user identified by the first image provider that the authorized user has been authorized to download a low resolution copy corresponding to one of the high resolution digital images, wherein the notifying means transmits at least a portion of a pathname associated with the low resolution copy of the authorized user (col. 1, lines 63-67 and col. 2, lines 1-4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have means for notifying an authorized user identified by the first image provider that the authorization has been authorized to download a low resolution copy corresponding to one of the high resolution digital images, wherein the notifying means transmits at least a portion of a pathname associated with the low resolution copy of the authorized user and to modify in Fredlund because such a modification would allow Fredlund to have a message as an identification of the user and/or identification of the digital image to which the third party has been granted access with the images including downloading a low resolution copy of the high resolution image with the message including an electronic address (URL designation for a World Wide Web site on the Internet).

With respect to claim 105, Fredlund teaches, further comprising means for processing the high resolution digital images to develop the corresponding low resolution copies (bonus prints) (col. 3, lines 64-67, col. 6, lines 23-29, and col. 8, lines 45-51).

With respect to claim 106, Fredlund did not teach, further comprising a mail database, the mail database including a conventional address for the authorized user, but it would have been obvious to one having ordinary skill in the art at the time the

invention was made to have a mail database, the mail database including a conventional address for the authorized user and to modify in Fredlund because such a modification would allow Fredlund to have a place to store the collected mail. A database by definition is a collection of data stored on a computer storage medium, such as a disk, that can be used for more than one purpose.

With respect to claim 107, Fredlund and Morris did not teach, further comprising a search engine for searching among digital images stored in the storage device, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a search engine for searching among digital images stored in the storage device and to modify in Fredlund because such a modification would allow Fredlund to have a computer program that searches through large amounts of text or other data which is well known in the art.

With respect to claim 108, Fredlund teaches, a storage device (col. 4, lines 34-36) and a transmitter for transmitting at least a portion of a pathname to the first authorized user via the Internet (col. 2, lines 28-30 and lines 33-42 and col. 5, lines 20-31). Fredlund and Morris did not teach, a mail server and a router but it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Fredlund to include a mail server and a router to perform the steps of claim 108 in view of Fredlund's modem and interactive cable TV network and because a mail server would allow Fredlund to have the ability to provide mail services to another computer (called a client) and to connect to two or more networks.

This independent claim is rejected for the similar rationale given above for claim 104.

With respect to claim 109, Fredlund did not teach, wherein the digital images are input to the system by the first image provider via a communication device.

Morris disclosed, wherein the digital images are input to the system by the first image provider via a communication device (col. 3, lines 44-67 and col. 4, lines 1-8). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the digital images input into the system by the first image provider via a communication device and to modify in Fredlund because such a modification would allow Fredlund to communications means (such as one or more modems or communications cards) and one or more digital processors for loading the digital images into the system.

With respect to claim 110, Fredlund teaches, an image handler (col. 2, lines 28-34 and lines 42-44) for processing the digital images input by the first image provider, the image handler being adapted to develop low resolution images of the digital images received from the first image provider and to store both the digital images received from the first image provider and the low resolution images thereof in the storage device in an addressable fashion for future searching (col. 4, lines 34-36 and lines 46-50).

With respect to claims 111 & 126, Fredlund teaches, storing a high resolution and a low resolution copy of a digital image provided by a first image provider in an electronically searchable format on a storage device (col. 4, lines 19-21).

These independent claims are rejected for the similar rationale given above for claim 108.

With respect to claim 112, Fredlund teaches, a storage device for storing digital images received from a first digital image provider and a second digital image provider (col. 3, lines 32-36).

Fredlund and Morris did not teach, a job order developer responsive to inputs received from the first user for developing a job order that includes at least one high resolution copy of a digital image contained in the subset and identified by the first user

and a user identifier for discriminating between users communicating with system to control user access to the digital images stored in the storage device, the user identifier limiting access to the digital images provided by the first digital image provider to at least one user identified by the first digital image provider, wherein the digital images provided by the first digital image provider are transparent to all users except users identified by the first digital image provider, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a job order developer responsive to inputs received from the first user for developing a job order that includes at least one high resolution copy of a digital image contained in the subset and identified by the first user and a user identifier for discriminating between users communicating with system to control user access to the digital images stored in the storage device, the user identifier limiting access to the digital images provided by the first digital image provider to at least one user identified by the first digital image provider, wherein the digital images provided by the first digital image provider are transparent to all users except users identified by the first digital image provider and to modify in Fredlund because such a modification would allow Fredlund to have a high resolution copy of the digital image which can be transmitted by an automatic e-mail notification to the third parties which have been granted access rights.

This independent claim has also rejected for the similar rationale given above for claims 106-108.

With respect to claim 122, this independent claim is also rejected for the similar rationale given above for claim 112.

With respect to claim 123, this independent claim is rejected for the similar rationale given above for claims 104-112 and 121-122.

With respect to claim 124, this independent claim is rejected for the similar rationale given above for claims 108 and 112.

With respect to claim 125, this independent claim is rejected for the similar rationale given above for claims 104 and 121.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Greenway et al (US 5,592,237) disclosed high resolution images and a storage facility.

Inquiries

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Tuesday-Thursday, 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'E. Colbert', is written over a horizontal line.

E. Colbert
Primary Examiner
December 17, 2005